

REMARKS

Claims 1, 2, 4-8, 10, 11 and 13-18 are pending in this application. By this Amendment, claims 1, 2, 4-8, 10, 11 and 13-18 are amended. The amendments introduce no new matter, as support can be found in the claims, in addition to page 7, lines 25-31, page 8, lines 9-17, and Figs. 3-6 of the specification, as originally filed. Claim 9 is canceled without prejudice to, or disclaimer of, the subject matter recited in that claim. Reconsideration of the application based on the above amendments and the following remarks is respectfully requested.

Applicants appreciate the courtesies shown to Applicants' representatives by Examiner Pham in the April 11, 2007 personal interview. Applicants' separate record of the substance of the interview is incorporated into the following remarks. Specifically, claim 1, 5 and 14 are amended to comply with the Examiner's helpful suggestions made during the interview.

The Office Action, on page 2, rejects claims 1, 2, 4-11 and 13-18 under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,144,452 to Abuyama in view of European Patent No. EP 996080 to Dawe et al. (hereinafter "Dawe"). This rejection is respectfully traversed.

Abuyama teaches a method for forming an output image in an image forming system. The Office Action concedes that Abuyama fails to automatically determine a location of an original portion of the input document containing image data. In addition, Abuyama does not explicitly teach or suggest determining a portion of the original image excluding any surrounding white-space portions of the input document. The Office Action alleges that Dawe overcomes the shortfall in the application Abuyama to the subject matter of the pending claims. Dawe is directed to method by which a user can highlight an input document prior to that input document being scanned with a differently-colored highlighter, in order to indicate a portion of the document to be extracted. The Office Action asserts that this user input of

using a ball-point pen, color highlighter, crayon or the like, discussed in, for example, paragraph 4 of Dawe allows undesirable surroundings including white-space to be excluded.

Dawe, therefore, requires some user modification of the input document prior to scanning in order that a specific portion of the document including image data is scanned. The analysis of the Office Action fails because this user-required input of Dawe cannot reasonably be considered to even have suggested the combination of automatic steps undertaken in, for example, claim 1. Further, despite the assertions to the contrary in the Office Action, it is unclear how, without Applicants' disclosure as a roadmap, one of ordinary skill in the art can reasonably be considered to have been motivated to make the asserted combination.

Applicants' representatives presented detailed arguments regarding the inapplicability of Dawe, and the non-combinability of Dawe and Abuyama, to Examiner Pham during the April 11 personal interview. In response, the Examiner indicated that he could broadly construe the combination of the applied references to at least suggest the combination of all of the features positively recited in, for example, claim 1. Applicants' representatives strongly traversed the Examiner's conclusions regarding the applicability of Dawe, and the combinability of Dawe with Abuyama. Examiner Pham remained unpersuaded.

Without conceding the propriety of any of the conclusions of the Office Action, as reiterated by Examiner Pham during the April 11 personal interview, Applicants voluntarily amend independent claims 1, 5 and 14 to clarify that the system and methods recited in those claims undertake the scanning step without any necessity for a user pre-modifying an input document in order to facilitate the scanning and/or determining steps as recited in the pending claims.

In other words, the claims are amended, as discussed during the April 11 personal interview, to incorporate the Examiner's helpful suggestion that the claims would be

allowable if amended to clarify that the scanning step occurs "without user input." Examiner Pham indicated to Applicants' representatives that amending the claim language in this manner would overcome the prior art rejection of the Office Action based on Dawe, which requires user input to select an image during scanning, in combination with Abuyama.

For at least the above reasons, Abuyama, in combination with Dawe, cannot reasonably be considered to have suggested the combinations of all of the features positively recited in independent claims 1, 5 and 14. Further, claims 2, 4, 6-8, 10, 11, 13 and 15-18, also would not have been suggested by Abuyama in view of Dawe for at least the respective dependence of these claims directly or indirectly on allowable independent claims 1, 5 and 14, as well as for the separately patentable subject matter that each of these claims recites.

In view of the foregoing, Applicants respectfully submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 2, 4-8, 10, 11, and 13-18 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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